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In re Application of	:	
John J. Malcolm et al.	:	
Application No.: 09/214406	:	DECISION
PCT No.: PCT/US97/11248	:	
Int. Filing Date: 28 June 1997	:	ON
Priority Date: 28 June 1996	:	
Attorney's Docket No.: NONE	:	PETITION
For: Combined Event Calendar and Picture Frame	:	

This is in response to the "Petition to Revive an Unavoidably Abandoned Patent Application Under 37 CFR 1.137(a)" filed on 12 October 1999, which is being treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

**BACKGROUND**

This international application was filed on 28 June 1997, designating the United States and claiming an earliest priority date of 28 June 1996. A Demand electing the United States was filed on 27 January 1997. Accordingly, the period for paying the basic national fee in the United States expired as of midnight on 28 December 1998.

On 28 December 1998, applicants submitted a "Request for National Stage Filing Under 35 U.S.C. 371" which included, *inter alia*, a small entity basic national fee, an unsigned Small Entity Declaration, and an unsigned combined declaration and power of attorney.

On 10 August 1999, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicants, indicating that the international application had become abandoned with respect to the United States for failure to timely pay the full required basic national fee, in that "a SIGNED small entity statement is required to claim small entity fees" but applicants had only submitted an unsigned small entity statement.

On 12 October 1999, applicants submitted the instant petition accompanied by, *inter alia*, a \$55.00 petition fee, an executed combined declaration and power of attorney and a signed Small Entity Declaration.

### **DISCUSSION**

Review of the record reveals that this application claims priority under 35 U.S.C. 120 of prior United States application number 08/672,449. Office records indicate that small entity status was established in that prior application. 37 CFR 1.28(a)(2) provides, in part, that

A nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application, or a reissue application may rely in a statement filed in the prior application or in the patent if the nonprovisional application or the reissue application includes a reference to the statement in the prior application or in the patent or includes a copy of the statement in the prior application or in the patent and status as a small entity is still proper and desired. The payment of the small entity basic statutory filing fee will be treated as such a reference for purposes of this section.

Petitioner paid the small entity basic national fee in this application on 28 December 1998. This payment will be treated as a reference to the small entity statement in prior application number 08/672,449. Thus, in accordance with 37 CFR 1.28(a)(2), applicants were entitled to pay the small entity basic national fee in this national stage application. As such, the Notification of Abandonment of 10 August 1999 was improper and is hereby **VACATED**.

### **DECISION**

The petition under 37 CFR 1.137(a) is **DISMISSED** without prejudice.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371. The date of this application under 35 U.S.C. 102(e) and 371 is **12 October 1999**.



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